

Page 7  
Serial No. 10/670,438  
Response to Official Action

**In the Drawings**

There are no amendments to the drawings.

**Remarks**

Applicant has amended Claim 5 and added new Claims 22 and 23. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. Entry of the amendment and favorable consideration thereof is earnestly requested.

Claim 1 recites among other limitations a “digital sensor for monitoring wear of a lining material of disc brakes, which sensor is adapted to be attached at an end of an adjustment shaft of an adjusting mechanism for adjusting the position of brake pads in relation to a brake disc” and “a first code part, said first code part being rotated continuously by rotation of the adjustment shaft and comprising a code wheel.” Claim 22 recites among other limitations “a first code part attached at an end of an adjustment shaft of an adjusting mechanism for adjusting the position of brake pads in relation to a brake disc . . . said first code part being rotated by rotation of the adjustment shaft” and “a second code part having a sliding part in the form of a code rack which is moved in a linear fashion by said first code part.” Applicant respectfully submits that none of the cited references teach, disclose or suggest these limitations.

For example, the Examiner has cited U.S. Patent No. 4,992,944 (Noto et al.) as disclosing all the limitations of Claim 1. However, Applicant respectfully submits that Noto et al. is directed toward an “electrically-operated power steering control system” and that the Examiner has pointed to the “steering angle sensor 10” as disclosing a “digital sensor for monitoring wear of a lining material of disc brakes” as recited by

Claim 1. (Abstract; Col. 4, line 11.) However, Claim 1 requires the first code part being rotated continuously by rotation of the adjustment shaft. Claim 1 identifies the adjustment shaft as “an adjusting mechanism for adjusting the position of brake pads in relation to a brake disc.” Nowhere does Noto et al. teach, disclose or suggest this limitation. Rather, Noto et al. discloses and teaches that the “steering angle sensor 10” is used “for detecting the rotational angle of a member adapted to rotate with the deflection of the tire.” (Col. 4, lines 12-14.)

Accordingly, because Noto et al. fails to disclose “a first code part, said first code part being rotated continuously by rotation of the adjustment shaft” it cannot anticipate Claim 1.

Applicant further submits that Claim 1 is not obvious in view of Noto et al. For example, nowhere does Noto et al. teach or suggest the “first code part being rotated continuously by rotation of the adjustment shaft.” Rather, as stated above, Noto et al. is directed toward a steering control system. Furthermore, it would not be obvious to modify Noto et al. to be used for monitoring wear of a lining material of disc brakes, which involves design criteria not addressed in Noto et al., for example, dealing with the relatively large heat build-up associated with braking systems (especially with heavy equipment). (See e.g., pars. 13-15.)

Applicant further submits that it is well settled that the mere fact that references can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. See, e.g., MPEP 2143.01; *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (fact that prior art “may be

capable of being modified to run the way the apparatus is claimed, there must be some suggestion or motivation in the reference to do so.”). In the present case, Applicant respectfully submits that Noto et al. is directed to a very different application and that there is no mention whatsoever of a “first code part being rotated continuously by rotation of the adjustment shaft” as recited in Claim 1. Applicant still further submits that there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification and that “knowledge can not come from the applicant's invention itself.” *In re Oetiker*, 977 F.2d, 1443, 1447 (Fed. Cir. 1992). See also *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (suggestion to modify must be found in the prior art, not the applicant's disclosure). In the present case, there is no suggest found in Noto et al. for making such a modification, rather, the only motivation for doing so would be the presently pending claims.

Accordingly, Applicant respectfully submits that because there is no motivation to modify Noto et al., Claim 1 cannot be obvious in view of Noto et al. Applicant further notes that the arguments presented in connection with Claim 1 further apply to Claim 22.

The Examiner has further cited U.S. Patent No. 4,934,474 (Sugasawa) against Claim 1. Applicant notes that, like Noto et al., Sugasawa is directed toward a “steer angle control system” and is not directed toward a system “for monitoring wear of a lining material of disc brakes” according to the presently pending claims. (Abstract) For example, the Examiner has stated that Sugasawa teaches use of “a first part 15 being ro-

tated continuously by rotation of the adjustment shaft" (See, Official Action 5/3/06, p. 3), however, Sugasawa teaches that item 15 is a "steering angle sensor 15" that "senses the steering wheel angle." (Col. 2, lines 33-36.) Nowhere does Sugasawa teach or suggest that the steering angle sensor 15 is rotated continuously by rotation of the adjustment shaft, where Claim 1 identifies the adjustment shaft as "an adjusting mechanism for adjusting the position of brake pads in relation to a brake disc."

Accordingly, Applicant respectfully submits that, because Sugasawa fails to teach or suggest a first code part, said first code part being rotated continuously by rotation of the adjustment shaft as recited by Claim 1, Sugasawa cannot render Claim 1 obvious. Applicant notes that Claim 22 recites "a first code part attached at an end of an adjustment shaft of an adjusting mechanism for adjusting the position of brake pads in relation to a brake disc" and as such, the same arguments apply to Claim 22.

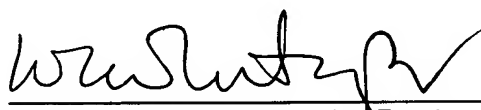
Applicant further submits that both Noto et al. and Sugasawa are directed to none related prior art (e.g. steering control systems, not braking monitoring systems) and one of ordinary skill in the art would not look to these references for solutions to the problems encountered with monitoring brake pad wearing. It is well settled that when considering a reference, the reference must be considered for its teachings as a whole and it is inappropriate to pick and choose various elements from the references without regard to what the references teach as a whole. *In re Arkley*, 455 F.2d 586, 587-88, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). In this case, neither Noto et al. nor Sugasawa teach or disclose a first code part attached at an end of an adjustment shaft of an adjusting mechanism for adjusting the position of brake pads in relation to a brake disc.

While the Examiner has pointed to certain elements of the prior art, the reference must be considered for what it teaches one of skill in the art as a whole, which is focused on steering control systems. See e.g. *W.L. Gore and Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13, (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (It is impermissible use the pending claims as a roadmap to select various features from the prior art to formulate an obviousness rejection.) The Examiner has not identified for example, how the steering control system could be modified to monitor brake pad wearing or be attached to an adjustment shaft that adjusts the position of a brake pad as it wears down. Accordingly, Applicant respectfully submits that neither Claim 1 nor Claim 22 can be obvious in view of the cited prior art.

It is respectfully submitted that claims 1-14 and 21-23, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

July 6, 2006



Wesley W. Whitmyer, Jr., Registration No. 33,558  
Steven B. Simonis, Registration No. 54,449  
Attorneys for Applicants  
ST. ONGE STEWARD JOHNSTON & REENS LLC  
986 Bedford Street  
Stamford, CT 06905-5619  
203 324-6155